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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Michael J. May

METHOD OF PRODUCING A
PACKAGE WRAPPER

10/075,976
Serial No. 09/434,660

Filed 05 November 1999

Group Art Unit: 3721

Examiner: Sameh Tawfik

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Tracey Thomas
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APPELLANT'S REPLY BRIEF

The present Reply Brief is in response to the Examiner's Answer mailed on September 22, 2005, for the above-identified application.

The Examiner's Answer has been received and reviewed. The Answer appears to consist of two parts. The first part is a verbatim restatement of the ground for rejection cited in the Final Rejection of in response to the first part of the Examiner's answer and, in response thereto, the Appellant refers to the argument presented in the Appeal Brief.

The second part of the Examiner's Answer begins at a section numbered (10) and entitled Response to Argument. As this section is understood by the Appellant, the Examiner presents four central arguments in the Response. The Appellant will now address each of these in turn.

1. The Examiner appears to contend that the actual printed wrapper of Jennel anticipates the claim language of "a package wrapper image including a representation of at least a portion of the package wrapper which includes the windowed image thereon." However, it is clear that the actual printed wrapper is neither an image nor a representation.

In the Examiner's answer, the Examiner states as follows:

...as broadly claimed "displaying a package wrapper image that includes a representation of at least a portion of a package wrapper which includes the windowed image thereon" is disclosed and suggested by General as shown in Figs. 1 and 2; via displaying package wrapper 26a and 26b includes the windowed image thereon via 36a and 36b. Note that appellant is not positively claiming displaying a package wrapper along with the windowed image on the display means; appellant [is] only using word [the] word "displaying" which does not require the display means.

The Appellant is unclear as to the nature of this rejection. To the extent that it is asserted that the mere printing of an image on the wrapping paper teaches this limitation, the Appellant notes that in claim 1, it is a package wrapper *image* that is displayed. Further, claim 1 also clearly states that the package wrapper image includes a *representation* of at least a portion of the package wrapper which includes the windowed image thereon. Displaying the actual printed wrapping paper would not constitute the presenting of an image nor would it constitute a representation of at least a portion of the wrapping paper as claimed.

The notation that there has been no positive claim that a package wrapper image is displayed along with the windowed image on a display means is not dispositive. As an initial matter, this is a method claim, thus it is not necessary to incorporate positively a means for display. Further, it is clear from claim 1, that what is displayed is a package wrapper *image*. The package wrapper image comprises a representation of at least one portion of the package wrapper which includes the windowed image thereon. Since what is displayed is an *image* that contains a *representation* of at least one portion of the package wrapper, it is clear that what is claimed is not the presentation of the package wrapper itself.

2. The Examiner further appears to contend that an image presented on the unnumbered display of image generator means 22 of Jennel comprises an unnumbered background portion that represents an image of the wrapper. However, Jennel does not describe an image to be printed as comprising a background portion and does not provide any support in the reference for contending that the image generator 22 presents an image that is a representation of the package wrapper as the image generating means is said to obtain images from two sources neither of which is said to be capable generating a package wrapper image including a representation of at least a portion of the package wrapper which includes the windowed image thereon.

This appears to be a new ground for rejection introduced for the purpose of this appeal. Specifically, the Examiner states that:

alternatively, the Examiner believes that such background of Jennel's display means 22 could be considered as the image of the package. For example, in Fig. 1 via image 36a on display 22 the background of the image on display 22 could be considered as an image of the package.

As an initial matter it will be appreciated that in Jennel, reference number 22 refers to an image generator 22 which has an unnumbered display. It will be appreciated from the following excerpts from Jennel that there are only two identified sources of images for the images to be presented on display 22:

As can be seen in FIGS. 1 and 2, a digital printing system 20 for printing directly on a web is provided. An electronically storable and retrievable digital graphic image 36a or 36b is generated at an image generator 22. The image generator 22 may be at a site away from the printing site 24. For instance, the image generator may be at a commercial design studio having apparatus such as digital cameras, scanners, desktop computers, and digital storage devices. The image generator 22 is connected to the printing site via a data transfer device 28 capable of transmitting digitally-generated images electronically. It is contemplated that the data transfer device 28 could include a telephonic modem or other electronic transfer medium, or could alternatively include some combination of electronic and physical transfer, if the image generator 22 is offsite from the printing site 24. If the image generator is on-site at the printing site, then the image generator 22 is connected via standard data lines to the printing site 24.b Jennel, Col. 4, lines 26 - 44. ...

The digital printing system 20 of the present invention allows for a digital graphic image 36a to be directly printed on a section of a web of packaging material 26a. The digital printing system 20 also allows for the immediate substitution of another digital graphic image 36b for the very next section of a web of packaging material 26b being processed at the printing site 24. Jennel, Col. 4, Lns. 45 - 51

The digital graphic image 36 may be created on a computer from a software program, or the digital graphic image 36 may be generated from a digital camera which transfers the image 36 via a disk to a computer 23 as shown in Figs. 1 and 2.

The digital printing system provides for a full color digital graphic image 36 to be printed directly onto a web 26.
Col. 4, lns. 60 – 66. (Emphasis supplied)

From this it is clear that there is no disclosure of any structure that would allow image generator 22 to generate a window on said image, to produce a windowed image said window being movable relative to the image, said windowed image comprising at least a portion of the image or to provide a package wrapper image for display that includes a representation of at least a portion of a package wrapper which includes the windowed image thereon.

Further there is no suggestion that image generator 22 should act in a manner to generate such a representation. Instead there is the suggestion that the image generator 22 could provide images from a digital camera or from some unspecified digital graphic program. At best image, image generator 22 of Jennel can be said to provide some image that is to be printed on a wrapper. This image is not intended as a representation of what this image will look like when printed on the wrapper itself but what the image will look like when the image is to be printed on the wrapper. Thus, it does not appear that image generator 22 is adapted to generate an image that contains a representation of at least a portion of a package wrapper which includes the windowed image.

This difference is not trivial as a variety of factors can cause the appearance of an image in the abstract to be substantially different than the appearance of the image as it will appear when recorded on the wrapper. For example, wrapper materials, shapes and contours can cause differences in the appearance of the image as illustrated in Fig. 8 of the pending application, the size of the image, the number of images printed per side of a wrapped object and other such information can be highly useful to a user.

To the extent that the Examiner contends that the “background” of image 36a could be considered to represent the appearance of the package, the Appellant respectfully submits that Jennel does not disclose presenting an image that is a representation a package wrapper because the only cited sources for an image are a digital camera and an unspecified computer program – neither of which are described as being capable of providing some form of image that is a representation of the package wrapper.

Further, there is no disclosure, that there is any “background” portion whatsoever in images 36a and 36b that are presented on the unnumbered displays

of image generator means 22 in Figs 1 and 2. Specifically, the only use of the word background in Jennel is the use of the word in the phrase "Background of the Invention". There is no discussion of a background portion and a foreground portion and the image or images are not described as being parseable in to foreground and background portions as is argued by the Examiner. Thus, the mere existence of a background portion of the image finds no support in the reference.

Further, even assuming that what is presented on the unnumbered display of image generator means 22 of Jennel could be considered to comprise images 36a and 36b having image portions (the cow of Fig. 1 and the airplane of Fig. 2) and background portions (the space surrounding the cow and the airplane) it will be appreciated that Jennel describes only the printing of an "image" or "images". Accordingly such images either include everything presented in the unnumbered display of Figs. 1 and 2, or such images include only the cow and airplane. If the former, then the image that is printed will constitute entire portion of the images 36a and 36b including whatever is in the space surrounding the cow and airplane will be printed and what is shown will constitute only an image that represents what the image generator 22 has instructed the printer to print. If the latter, then Jennel provides no support whatsoever for the contention that that the space surrounding the cow or airplane images represents anything or is anything other than empty space.

Therefore what is shown on the unnumbered display of image generator means 22 will constitute only a representation of an image to be printed and not a *a package wrapper image including a representation of at least a portion of the package wrapper which includes the windowed image thereon.*

Accordingly, the new argument presented in the Examiner's reply fails

3. The Examiner appears to contend that Hinton wherein a user can select from one of a plurality of different borders for application to a print suggests the step of "providing a window on said [user provided] image to produce a windowed image said window being moveable relative to the user provided image. However, the Examiner's argument fails in that changing border patterns does not inherently constitute movement "relative to the image" as claimed.

The essential argument presented by the Examiner is that Hinton, in teaching that a user can select a border for application to an image from among a plurality of borders that might have different border sizes or characteristics, suggests a window that is moveable relative to a user provided image. However, this argument fails in that the Examiner's argument only establishes that the shape of a window can be changed but by extension of the argument, it is not necessary for the location of the border to be moved relative to the image for this to occur.

4. The sole cited motivation to combine Jennel and Hinton is to provide for the printing of general images onto a package web. However, there is no showing that these references themselves establish the cited motivation. Further, this motivation does not suggest that such a combination would be made to accomplish the method steps that are claimed and, in fact, the combination would teach away from this method.

In the Examiner's Answer, the Examiner contends that

Examiner believes that since both reference of Jennel and Hinton relating to printing images into web/board, then it would be obvious to one skilled in the art to consider the teaching of printing personalized image into board/web as suggested by Hinto[n]. to combine it to teaching of printing general images into package web.

It will be appreciated that this argument fails to establish any motivation in the references themselves suggesting such a combination as is required under In Re. Lee. Further, this motivation appears to be in violation of the standards established in In Re: Lee 277 Fed. 3d, 1388 61 USPQ 2d 1430 (Fed. Cir. 2002), which provides that the Examiner can satisfy the burden of showing obviousness of a combination "only by showing some objective teaching in the prior art or in that knowledge generally available to one of ordinary skill in the art that would lead that individual to combine the relevant teachings of the references." In particular, the Examiner's Answer fails to provide, any showing that the above cited motivation is based upon either some objective teaching in the references themselves or to provide any showing of some objective evidence in, that knowledge generally available to one of ordinary skill in the art, that would lead to such a motivation for this combination to justify the combination of these two disparate references. As such the motivation for the combination appears to be the impermissible use of hindsight.

Further, as noted in the Appeal Brief, such a combination teaches away from the claimed invention in that, at best, such a combination would merely teach printing customized images having border on a package all without providing the display of a package wrapper image as claimed herein.

From this it will be appreciated that the Examiner's cited motivation further fails to provide any motivation for one of ordinary skill in the art to combine these references in the manner claimed herein as here too, the cited motivation for the combination has been to provide only customized images on a package and not to do so in the manner claimed.

Conclusion

For these reasons and for the reasons cited in the Appellant's Appeal Brief, the Appellant respectfully submits that the Examiner's Answer fails to adequately address the arguments presented in the Appeal Brief and respectfully requests that the Board of Patent Appeals and Interferences reverse the rejection by the examiner and mandate the allowance of claims 1-3, 5 - 8, 23, and 24.

Respectfully submitted,



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